

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUICHI YAMATO

Appeal No. 1999-2633
Application 08/680,325

ON BRIEF

Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Yuichi Yamato appeals from the final rejection of claims 5 through 12, all of the claims pending in the application.

THE INVENTION

The invention relates to "a makeup sponge puff used for applying makeup beauty products" (specification, page 1).

Representative claims 1 and 12 read as follows:

5. A makeup sponge puff comprising a closed-cell foam sponge substrate having an exterior surface with a plurality of cavities formed therein and a plurality of particles discontinuously adhered to the exterior surface of said closed-cell foam sponge substrate including said cavities.

12. A makeup sponge puff comprising a closed-cell foam substrate having an exterior surface with a plurality of cavities formed therein and a plurality of particles discontinuously adhered to the exterior surface of said closed-cell foam sponge substrate including said cavities, wherein said closed-cell foam substrate comprises a material selected from the group consisting of natural sponge, NBR, silicone-modified EPDM and EPDM and said particles are selected from the group consisting of a thermoplastic resin, a synthetic rubber and a thermosetting resin and are adhered to the exterior surface of the closed-cell foam sponge substrate by an adhesive layer provided thereon or are either thermally fused to the exterior surface to the closed-cell foam sponge substrate or adhered thereto through crosslinking.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Ebert et al. (Ebert)	4,464,428	Aug. 7, 1984
Hermann	4,828,542	May 9, 1989
Fujimoto et al. (Fujimoto)	5,434,194	Jul. 18, 1995

THE REJECTIONS

Claims 5 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ebert.

Claims 5 through 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto in view of Hermann.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 10 and 12) and to the examiner's answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

¹ In the final rejection (Paper No. 5), claims 5 and 11 also stood rejected under 35 U.S.C. § 102(e) as being anticipated by

DISCUSSION

I. Preliminary matter

On August 24, 2001, this Board issued an order (Paper No. 14) remanding the application to the examiner to deal with certain procedural matters. The examiner responded via a memorandum to the Board dated September 24, 2001. As the record does not show that the memorandum was ever mailed to the appellant, a copy thereof is appended to this decision.

II. The 35 U.S.C. § 102(b) rejection of claims 5 and 6 as being anticipated by Ebert

Ebert discloses a web of soft plastic foam material having a closed cell structure for "diverse applications in the automotive field, in the field of insulation, in the manufacture of toys, camping equipment, sport articles, packing material, seat coverings, apparel and orthopedic products, advertising and display articles and in the building construction industry" (column 1, lines 17 through 22). In general, the web includes parallel upper and lower surfaces and canals (preferably circular or polygonal holes) which penetrate the web, open to at least one of the upper and lower surfaces, and selectively receive various

Fujimoto, and in the alternative under 35 U.S.C. § 103(a) as being obvious over Fujimoto. Upon consideration of the arguments advanced in the main brief, the examiner has withdrawn these rejections (see pages 2, 6 and 7 in the answer).

particles which permit adjustment of the web's permeability to heat, moisture, and sound. These particles may comprise synthetic plastic materials (see column 2, lines 55 through 61) and can be joined adhesively to the walls of the canals by thermoplastically softening the foam or using a reactive adhesive (see column 2, lines 33 through 39).

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's analysis as to how the limitations in claims 5 and 6 read on Ebert appears on pages 3, 4 and 6 in the answer. The appellant (see pages 3 through 5 in the main brief and pages 1 and 2 in the reply brief) maintains that this analysis is flawed, and thus the rejection is unsound, because Ebert does not

meet the limitation in claim 5 requiring the plurality of particles to be "discontinuously adhered to the exterior surface of said closed-cell foam sponge substrate including said cavities." According to the appellant, Ebert's particles are adhered to the inside profiles of the canals rather than to the exterior surface of the foam substrate.

Claim 5 defines the foam sponge substrate recited therein as having "an exterior surface with a plurality of cavities formed therein." This definition is consistent with the underlying specification and drawings which describe and show a surface 11, including cavities, on the upper side of substrate sponge 10. Particles 15 are "discontinuously adhered" to this surface, including the cavities, in the sense "so as not to occupy all of the surface 11" (specification, page 3). The appellant has not cogently explained, nor is it apparent, why the upper surface and canals of Ebert's web do not collectively constitute an exterior surface with a plurality of cavities formed therein to the same extent that the surface 11 on the appellant's substrate does. Moreover, given that Ebert's particles are adhered within the canals but not to the upper surface, it is not apparent why they do not constitute a plurality of particles which are "discontinuously adhered" to the exterior surface of the closed-

cell foam sponge substrate including the cavities as recited in claim 5.

Thus, the appellant's position that the claim 5 limitation at issue distinguishes the subject matter recited in claim 5 and dependent claim 6 over Ebert is not persuasive. We shall therefore sustain the standing 35 U.S.C. § 102(b) rejection of claims 5 and 6 as being anticipated by Ebert.

III. The 35 U.S.C. § 103(a) rejection of claims 5 through 12 as being unpatentable over Fujimoto in view of Hermann

Fujimoto, the primary reference in this rejection, discloses a cosmetic puff or sponge made of a closed cell rubber substrate, preferably a silicone-modified ethylene-propylene-dienomethylene (EPDM) rubber substrate (see column 2, lines 38 through 42 and 66 through 68). According to Fujimoto, the closed cell nature of the puff/sponge "prevents water or liquid foundation from entering into the inside thereof. Thus, the sponge can be readily washed with water and is likely to dry, ensuring good sanitary conditions" (column 3, lines 44 through 48).

As acknowledged by the examiner (see page 5 in the answer), Fujimoto does not respond to the particle limitations in claims 5 through 12. To overcome this deficiency, the examiner turns to Hermann.

Hermann discloses an open cell foam substrate having pre-formed active ingredient particles bonded thereto during the foam polymerization process. The particles comprise small droplets of an active ingredient, such as a cosmetic (see column 1, lines 15 through 25; column 9, lines 21 through 23; column 9, line 63, through column 10, line 2), stored within an encapsulating film of polymeric material, such as polyethylene or polypropylene (see column 7, lines 16 through 22), which ruptures under selective pressure to dispense the active ingredient. In some applications, the particles can be distributed and bonded throughout the foam substrate (see Figure 1 and column 10, line 56, through column 11, line 11), and in other applications the particles may be bonded only to the surface area of the substrate to form an exposed surface layer composed of the foam substrate and the active ingredient particles (see column 8, line 66, through column 9, line 35; and column 12, lines 5 through 42).

In proposing to combine Fujimoto and Hermann to reject claims 5 through 12, the examiner concludes that

[i]t would have been obvious to the skilled artisan to have fixed active particles, as taught in Hermann, to a surface of the closed-cell puff taught in Fujimoto, motivated by the desire to obtain a cosmetic puff which exhibited good sanitary conditions and had microcapsules containing personal care products limited to just the surface of the foam substrate. While Hermann is specific to the fact that a[n] open-celled

foam should be used, his stated purpose of this is to obtain a distribution of active ingredient particle[s] throughout the entire foam substrate (column 3, line 67 et seq.). Thus, the skilled artisan would recognize that Hermann does not teach away from the use of a closed-cell foam, but rather would recognize that the active ingredient particles could likewise be bonded to a closed-cell foam, if the skilled artisan desired to limit the distribution of the active ingredient particles to just the surface area of the foam substrate [answer, pages 5 and 6].

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

In the present case, Fujimoto's teaching of the sanitary nature of the closed cell cosmetic puff disclosed therein and Hermann's teaching of a foam cosmetic applicator having active ingredient particles bonded thereto for the convenient storage, protection, release and application of the cosmetic would have furnished the artisan with ample motivation or suggestion to adhere Hermann's cosmetic particles to the exterior surface of Fujimoto's closed-cell foam sponge substrate to take advantage of the foregoing benefits. The combined teachings of the references

in this regard belie the appellant's hindsight arguments which rest on the individual deficiencies of each reference relative to the subject matter claimed. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

The appellant's reliance on the comparative test data set forth on page 5 in the instant specification to demonstrate "the superior effects associated with the sponge puff of the present invention" (main brief, page 8) is not well taken. To begin with, the specification fails to describe in any meaningful way the "conventional sponge puff" to which the inventive sponge puff is compared. Moreover, when an article is said to achieve unexpected (i.e., superior) results as shown by comparative tests, the results must logically be shown as superior compared to the closest prior art. In re Baxter Travenol Labs., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Here, the record is devoid of any evidence that the "conventional sponge puff" tested embodies a puff of the sort disclosed by the closest prior art, Fujimoto.

Thus, the combination of Fujimoto and Hermann proposed by the examiner is well founded. This combination also responds to all of the limitations in claims 5 through 7, 9, 11 and 12. More particularly, particles applied to the cavity-pocked exterior surface of Fujimoto's closed cell puff via Hermann's surface bonding technique (see column 8, line 66, through column 9, line 35; and column 12, lines 5 through 42) would result in the particles being discontinuously adhered to the exterior surface of Fujimoto's closed cell foam substrate including the cavities as set forth in claims 5 and 12, with the particles being thermally fused to the exterior surface of the foam sponge as recited in claims 9 and 12. Fujimoto's silicone-modified EPDM foam rubber constitutes a rubber as recited in claims 7, 11 and 12, and the exemplary polyethylene or polypropylene encapsulating films of Hermann's particles constitute thermoplastic resins as recited in claims 6 and 12.²

On the other hand, the Fujimoto and Hermann combination does not on its face result in an adhesive layer on the exterior surface of the sponge substrate to which the particles are

² Claims 6, 11 and 12 contain recitations of one or more Markush groups (see MPEP § 2173.05(h)). The recitation of a Markush group is met by the prior art if at least one of the alternative elements in the group is met.

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adhered as recited in claim 8, or in particles adhered to the exterior surface of the sponge through crosslinking as recited in claim 10.

In light of the foregoing, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 5 through 12 as being unpatentable over Fujimoto in view of Hermann with respect to 5 through 7, 9, 11 and 12, but not with respect to claims 8 and 10.

SUMMARY

The decision of the examiner to reject claims 5 through 12 is affirmed with respect to 5 through 7, 9, 11 and 12, and reversed with respect to claims 8 and 10.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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